

REMARKS

Applicants respond to the Office Action ("OA") dated May 21, 2003, with the following remarks. Applicants note that box 4a of the Office Action Summary incorrectly states that claims 186-190 have been withdrawn. Applicants submit that claims 1-150 and 156-185 have been withdrawn, and that claims 151-155 and 186-195 remain pending in this application.

INFORMATION DISCLOSURE STATEMENT

In the Office Action, the Examiner objected to the information disclosure statement ("IDS") filed January 27, 2003, under 37 CFR 1.56, and declined to consider the IDS on its merits (OA, ¶ 1). In response, Applicants respectfully submit that Applicants have submitted the IDS in compliance with their duty of disclosure under 37 CFR 1.56, without deceptive intent, and that the IDS should be considered by the Examiner. In submitting this rather lengthy IDS, Applicants were mindful of the Federal Circuit's advice that "a patent applicant should err on the side of disclosure." *LNP Eng'g Plastics, Inc. v. Miller Waste Mills, Inc.*, 275 F.3d 1347, 1361 (Fed. Cir. 2001). Indeed, most, if not all, of the references cited were cited by the Applicants in prior related applications or were raised by Microsoft as relevant art in an ongoing patent litigation involving related patents.

Beyond this, Applicants note that the Office specifically instructs Examiners not to comment on duty of disclosure issues:

the Office does not investigate and reject original or reissue applications under 37 CFR 1.56. Likewise, the Office will not comment upon duty of disclosure issues which are brought to the attention of the Office in original or reissue applications except to note in the application, in appropriate circumstances, that such issues are no longer considered by the Office during its examination of patent applications.

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Examination of lack of deceptive intent in reissue applications will continue but without any investigation of inequitable conduct issues. Applicant's statement of lack of deceptive intent normally will be accepted as dispositive except in special circumstances such as an admission or judicial determination of fraud or inequitable conduct.

M.P.E.P. § 2010.

SPECIFICATION

In the Office Action, the Examiner objected to the title as not descriptive and requested that Applicants amend the title (OA, ¶ 2). Applicants have considered the Examiner's objection but respectfully disagree. Like the current title, the claims of this application relate to selecting, matching, classifying, and/or narrowcasting information to the user. Applicants therefore respectfully request that the Examiner reconsider this objection.

The Examiner also objected to the specification as purportedly using terms that "lack ordinary meaning" or which were "undefined in the specification" or "used in a manner inconsistent with their ordinary meaning." (OA, ¶ 3). During the telephone conference, the Examiner indicated that these objections were based on similar arguments proposed by Microsoft attorneys in the related litigation. Applicants caution the Examiner that, while Microsoft has advanced these arguments during litigation with regard to other claims at issue in the litigation, but not before the Examiner, the Court has not yet found these arguments to have any basis. In fact, the Court has denied Microsoft's Motion for Summary Judgment on indefiniteness, in which these arguments were advanced and had no difficulty construing claims using these terms. See the July 3, 2003 Order of Judge Armstrong (Exhibit 6 of the Second Updated Notice of Related Litigation, filed concurrently herewith). For at least these reasons, Applicants

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respectfully request that the Examiner withdraw the objections to the specification.

35 U.S.C. § 112 REJECTIONS

The Examiner rejected claims 151-155 and 186-195 under 35 U.S.C. § 112 ¶ 1, as purportedly containing subject matter which was not described in the specification (OA, ¶ 4), and under 35 U.S.C. § 112 ¶ 2, for purportedly containing a number of terms which are indefinite (OA, ¶ 5). Applicants reiterate that, although similar arguments were advanced by Microsoft in a related litigation, these arguments are without merit. Applicants direct the Examiner to the March 14, 2003, Joint Claim Construction and Prehearing Statement (Exhibit 1 of the Second Updated Notice of Related Litigation), which shows representative support for the claim terms mentioned by the Examiner. Furthermore, as referred to above, Microsoft's claims of "indefiniteness" were rejected by the Court and the Court had no difficulty construing the claims, many of which contained the same terms objected to by the Examiner in this application. See the July 3, 2003, Order of Judge Armstrong (Exhibit 6 of the Second Updated Notice of Related Litigation). For at least these reasons, Applicants respectfully request that the Examiner withdraw all rejections to claims 151-155 and 186-195 under 35 U.S.C. § 112.

35 U.S.C. § 102(B) REJECTION

The Examiner rejected claims 151-155 and 186-195 under 35 U.S.C. § 102(b) as anticipated by WO 96/27155, without further comment. Although WO 96/27155 is also assigned to InterTrust, Applicants respectfully submit that the cited reference is complex and describes inventions other than that claimed by the applicant in this application.

Therefore, the Examiner has an obligation to indicate the particular part of the reference

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that the Examiner relies on for the rejection. See 37 CFR 1.104(c)(2). Applicants respectfully submit that, in this case, the Examiner has not done so.

Nonetheless, Applicants respectfully traverse this rejection and submit that claims 151-155 and 186-195 are patentable over WO 96/27155 because these claims teach aspects that are not taught by this reference. For example, WO 96/27155 does not teach "associating a first rule with the secure container, the first rule at least in part governing use of at least some of the secure container contents, the first rule at least in part specifying potential users or recipients of the secure container contents, the specification being based at least in part on a class to which the potential users or recipients have been assigned," as recited in claim 151. In addition, WO 96/27155 does not teach "receiving a request for a content object from a potential user or recipient, the request specifying a desired class of rights management information; determining that the first content object has rights management information associated with it that belongs to the desired class" and "determining, based at least in part on the digital certificate, that the potential user or recipient has been assigned to the first class," as is also recited by claim 151. For at least these reasons, claim 151 is patentable over the cited reference, as are claims 152-155 and 186-190 which depend from claim 151.

In addition, WO 96/27155 does not teach "assigning a potential user or recipient to a class, the assignment being based at least in part on information regarding the potential user or recipient's previous use of content" and "associating a first rule with the secure container, the rule at least in part governing use of at least some of the secure container contents, the first rule at least in part specifying potential users or recipients of the secure container contents, the specification being based at least in part on the class

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to which the potential users or recipients have been assigned," as recited by claim 191. WO 96/27155 further does not teach "determining, based at least in part on the digital certificate, that the potential user or recipient has been assigned to the class," as recited by claim 191. For at least these reasons, claim 191 is patentable over the cited reference, as are claims 192-195 which depend from claim 191.

CONCLUSION

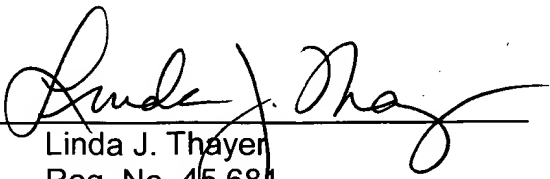
In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims. If the Examiner believes a telephone interview would expedite the prosecution of this application, the Examiner is invited to contact Linda J. Thayer at (650) 849-6621.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: November 21, 2003

By: 
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